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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/376,748	08/17/1999	STEPHEN D. LAND	COBS113813	6860

23552 7590 06/02/2003

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EXAMINER

PHAM, KHANH B

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/376,748

Applicant(s)

LAND ET AL.

Examiner

Khanh B. Pham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on April 16, 2003 has been entered. **Claims 1, 5, 48, and 50 have been amended.**

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-16, 19-30, 37, 39, 48, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (US 6,021,412) and in view of Murakami et al. (US 6,108,674).

**As per claim 1**, Ho teaches a method for searching a database comprising:

- "automatically creating a query directly from the indicated object that is located within the document, the query including at least a portion of the indicated object

and having a data structure that is recognizable by a search engine for the database” at Col. 1 lines 50-63 and Fig. 8;

- “providing the query to the search engine, the search engine searching the database for at least one object that is related to the indicated object” at Col. 1 lines 63-67 and Figs. 9-10;
- “returning the result from the query of the database, the result indicating when at least one object is related to the indicated object” at Col. 1 lines 63-67 and Fig. 10;
- “producing a display of a related object, so that the related object may be associated with the indicated object” at Col. 1 line 67 to Col. 2 line 3 and Fig. 12.

The difference between Ho and the invention of claim 1 is that Ho’s method requires user to select a word from the list of concept matching words to create the query, and therefore Ho does not teach: “ the query is created without having a user make a selection for the query in a separate document”. However, Murakami teaches a similar method for searching a database to obtain an object that is related to an indicated object in a document (Col. 4 line 5 to Col. 5 line 30), wherein “the query is created without having a user make a selection for the query in a separate document”.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ho’s method to automate the step of “having a user to make a selection for the query in a separate document” as suggested by Murakami, in order to provide a more efficient method that reduces labor, time and burden on the user.

**As per claim 2**, Ho and Murakami teach the same as stated in claim 1 above. Ho also teaches: “the indicated object and the related object include data, the data comprising video, picture, sound, and text” at Col. 3 lines 1-10.

**As per claim 3**, Ho and Murakami teach the same as stated in claim 1 above. Ho also teaches:

- “enabling a qualification engine to determine a context of the indicated object” at Col. 1 lines 50-65;
- “employing the context of the indicated object to automatically create the query for the database” at Col. 1 lines 63-67.

**As per claim 5**, Ho teaches “a method for obtaining an image from a database for insertion into a document” (Col. 1 lines 35-40) comprising:

- “enabling an automatic creation of a query directly from the indicated text that is located within the document, the query including at least a portion of the indicated object and having a data structure that is recognizable by a search engine for the database” at Col. 1 lines 50-63;
- “providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text” at Col. 1 lines 63-67;
- “returning the result from the query of the database, the result indicating when at least one image is related to the indicated text” at Col. 1 lines 63-67;
- “enabling the display of at least one image indicated by the result from the query, a displayed image being selectable for insertion into the document” at Col. 1 line 67 to Col. 2 line 5.

- "displaying a related image that is inserted into the document, so that the related image is associated with the indicated text in the document" at Fig. 12.

The difference between Ho and the invention of claim 5 is that Ho's method requires user to select a word from the list of concept matching words to create the query, and therefore Ho does not teach: " the query is created without having a user make a selection for the query in a separate document". However, Murakami teaches a similar method for searching a database to obtain an object that is related to an indicated object in a document (Col. 4 line 5 to Col. 5 line 30), wherein "the query is created without having a user make a selection for the query in a separate document".

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ho's method to automate the step of "having a user to make a selection for the query in a separate document" as suggested by Murakami, in order to provide a more efficient method that reduces labor, time and burden on the user.

**As per claim 6,** Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: "employing a user interface component to automatically create the query for the database, the creation of the query being related to the indicated text" at Fig. 2-4 and Figs 7-9.

**As per claim 7,** Ho and Murakami teach the same as stated in claim 6 above. Ho teaches: "the user interface component enables the indicated text to be edited" at Col. 3 line 63 to Col. 4 line 2.

**As per claim 8**, Ho and Murakami teach the same as stated in claim 6 above. Ho also teaches: "the user interface component enables the indicated text to be chosen in the document" at Col. 3 lines 40-50.

**As per claim 9**, Ho and Murakami teach the same as stated in claim 8 above. Ho also teaches: "choosing the indicated text in the document for the query of the database from within an application program that provides the document" at Col. 3 lines 50-55.

**As per claim 10**, Ho and Murakami teach the same as stated in claim 9 above. Ho also teaches "choosing a command to create the query for the indicated text, the command including an indication in a context menu, drop-down menu, pop-up window, dialogue box, toolbar and hot key" at Fig. 4.

**As per claim 11**, Ho and Murakami teach the same as stated in claim 8 above. Ho also teaches: "choosing the indicated text in the document for the query of the database from an application program that is separate from another application program that provides the document" at Col. 4 lines 20-25.

**As per claim 12**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: "enabling the indicated text to be chosen in another application program that does not provide the document, including a clipboard program" at Col. 4 lines 20-25.

**As per claim 13**, Ho and Murakami teach the same as stated in claim 6 above. Ho also teaches:

- “enabling a qualification engine to determine a context of the indicated text within the document” at Col. 1 lines 50-65.
- “providing the context of the indicated text to the user interface component, the user interface component employing the context of the indicated text to automatically create the query for the database” at Figs. 6-9.

**As per claim 14**, Ho and Murakami teach the same as stated in claim 13 above. Ho also teaches: “the determined context of the indicated text includes text, template, sound, video, picture, use and user preference” at Col. 9 lines 25-30.

**As per claim 15**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches “the search engine is a local search engine, the local search engine employing the query to search for related images on a local drive that includes the database” at Col. 4 lines 3-25.

**As per claim 16**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “ the local drive includes hard disk, floppy disk, tape drive, DVD and CD-ROM” at Col. 4 lines 3-10.

**As per claim 19**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “further comprising employing a result component to manage the result of the query returned by the search engine, the result component enabling the parsing, storing and display of the result of the query” at Col. 3 lines 30-35.

**As per claim 20**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “the result is in a metadata format” at Col. 6 lines 15-20.



**As per claim 21**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: "requesting at least one related image from the database that is indicated by the result of the query, the related image being provided as binary image data" at Col. 3 lines 30-35.

**As per claim 22**, Ho and Murakami teach the same as stated in claim 21 above. Ho also teaches: "employing an image component for managing the storage and display of binary image data" at Figs. 10-11.

**As per claim 23**, Ho and Murakami teach the same as stated in claim 21 above. Ho also teaches: "employing a navigation component to provide at least one control for displaying at least one related image" at Figs. 10-11.

**As per claim 24**, Ho and Murakami teach the same as stated in claim 21 above. Ho also teaches: "a navigation component enables the display of a group of related images in a slide show, the group of related images being indicated in the result from the query" at Figs. 10-11.

**As per claim 25**, Ho and Murakami teach the same as stated in claim 24 above. Ho also teaches: "the navigation component enables another group of related images to be displayed in the slide show, the other group of related images being indicated in the result from the query" at Figs. 10-11.

**As per claim 26**, Ho and Murakami teach the same as stated in claim 24 above. Ho also teaches: "the navigation component includes a control for determining a period of time that each related image is displayed in the slide show" at Figs. 10-11.

**As per claim 27**, Ho and Murakami teach the same as stated in claim 24 above. Ho also teaches: “the navigation component includes a control for indicating the number of the related image in the group that is currently displayed in the slide show” at Figs. 10 – 11.

**As per claim 28**, Ho and Murakami teach the same as stated in claim 25 above. Ho also teaches: “the navigation component includes a control for indicating each group of related images that are currently displayed in the slide show” at Figs. 10 – 11.

**As per claim 29**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “enabling a help facility to provide an explanation of a chosen topic and the help facility being launched in response to an input” at Figs. 10-11.

**As per claim 30**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “the display of at least one related image further comprises displaying a thumbnail of the related image” at Figs. 10-11

**As per claim 37**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “each time indicated text is employed to create the query, automatically saving the indicated text as an entry in a history file; and enabling at least one of the entries in the history file to be chosen for the currently indicated text” at Figs. 6-9.

**As per claim 39**, Ho and Murakami teach the same as stated in claim 5 above. Ho also teaches: “automatically determining a word that is closest to a cursor

when no indicated text is provided and employing the determined word as indicated text” at Col. 7 lines 15-20.

**As per claim 48**, Ho teaches “a system for obtaining an image from a database for pasting into a document” (Col. 1 lines 35-40) comprising:

- “a client process for causing functions to be performed, including: enabling an automatic creation of a query directly from the indicated text that is located within the document, the query including at least a portion of the indicated object and having a data structure that is recognizable by a search engine for the database” at Col. 1 lines 50-67;
- “providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text” at Col. 1 lines 63-67;
- “enabling a display of at least one related image indicated by the result from the query, the display of a related image being selectable for insertion into the document” at Col. 3 lines 30-35;
- “displaying the related image that is inserted into the document, the related image being associated with the indicated text in the document” at Figs. 10-11;
- “a server process for causing functions to be performed, including: returning the result from the query of the database, the result indicating when at least one image is related to the indicated text” at Col. 3 lines 25-30;
- “enabling the search engine to locate at least one image in the database that is related to the indicated text” at Col. 3 lines 25-30.

The difference between Ho and the invention of claim 48 is that Ho's method requires user to select a word from the list of concept matching words to create the query, and therefore Ho does not teach: "the query is created without having a user make a selection for the query in a separate document". However, Murakami teaches a similar method for searching a database to obtain an object that is related to an indicated object in a document (Col. 4 line 5 to Col. 5 line 30), wherein "the query is created without having a user make a selection for the query in a separate document".

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ho's method to automate the step of "having a user to make a selection for the query in a separate document" as suggested by Murakami, in order to provide a more efficient method that reduces labor, time and burden on the user.

**As per claim 50**, Ho teaches "a computer readable medium having computer-executable components" comprising:

- "a component for automatically creating a query directly from indicated text that is located within the document, the query including at least a portion of the indicated object and having a data structure that is recognizable by a search engine for a database" at Col. 1 lines 50-67;
- "a component for providing the query to the search engine, the search engine searching the database for an image that is related to the indicated text" at Col. 1 lines 63-67;

- “a component for returning the result from the query of the database, the result indicating when at least one image is related to the indicated text” at Col. 1 lines 63-67;
- “a component for enabling the display of at least one related image indicated by the result from the query, the display of the related image being selectable for insertion into the document” at Col. 3 lines 30-35;
- “a component for displaying the related image that is inserted into the document, so that the related image is associated with the indicated text in the document” at Fig. 12.

The difference between Ho and the invention of claim 50 is that Ho's method requires user to select a word from the list of concept matching words to create the query, and therefore Ho does not teach: “ the query is created without having a user make a selection for the query in a separate document”. However, Murakami teaches a similar method for searching a database to obtain an object that is related to an indicated object in a document (Col. 4 line 5 to Col. 5 line 30), wherein “the query is created without having a user make a selection for the query in a separate document”.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ho's method to automate the step of “having a user to make a selection for the query in a separate document” as suggested by Murakami, in order to provide a more efficient method that reduces labor, time and burden on the user.

5. **Claims 4, 18, 31-36, 38, 40-47, 49, 51-53 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Ho and Murakami as applied to claims 1-3, 5-16, 19-30, 37, 39, 48, 50 above, and further in view of Balogh et al. (U.S Patent 5,493,677).

**As per claim 4**, Ho and Murakami teach the claimed invention as discussed above. Ho and Murakami does not teach the step of “indicating the related object is to be purchased over a network; and providing financial information to an electronic commerce service over the network, the electronic commerce service enabling the purchase of the related object when the financial information is complete”.

However, Balogh teaches the cited steps as “if the user selects the pricing button from lightbox commands area or info screen commands area, pricing screen is displayed, enabling the user to purchase rights to, and obtain delivery of , selected images ...” at Col. 17 lines 25-65. Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine Ho and Murakami database searching method with Balogh’s purchasing step so that “the user may order and obtain delivery of selected images directly over a computer connection” (Balogh, Col. 2 lines 5-7).

**As per claim 18**, Ho and Murakami teach the same as stated in claim 5 argument. Balogh’s teaches the step of “employing a network component to communicate with the search engine over a network, the network including an intranet and the Internet” at Fig. 11.

**As per claim 31**, Ho and Murakami teach the same as stated in claim 5 arguments. Balogh’s teaches the step of “including a digital watermark with the related

image, the digital watermark including information related to the content of the related image” at Fig. 5.

**As per claim 32**, Ho and Murakami teach the same as stated in claim 5 arguments. Balogh teaches: “including a cookie with the query, the cookie including information related to a user” at Col. 9 lines 15-35.

**As per claim 33**, Ho and Murakami teach the same as stated in claim 5 argument. Ho also teaches the step of “inserting a higher quality image into the document so that the higher quality image is displayed with the indicated text” at Fig. 12. Balogh teaches the step of “indicating a higher quality image of the related image is to be purchased over a network; and providing financial information to an electronic commerce service over the network, the electronic commerce service enabling the purchase of the higher quality image when the financial information is complete” at Col. 17 lines 25-65.

**As per claim 34**, Ho and Murakami teach the same as stated in claim 5 argument. Balogh teaches “employing an electronic shopping cart to store a potential purchase of the higher quality image” at Col. 17 lines 25-40.

**As per claim 35**. Ho and Murakami teach the same as stated in claim 5 argument. Balogh teaches: “enabling a parameter of the higher quality image to be indicated” at Col. 17 lines 28-38.

**As per claim 36**, Ho and Murakami teach the same as stated in claim 5 argument. Balogh teaches: “enabling a use of the higher quality image to be indicated” at Col. 17 lines 50-55.

**As per claim 38**, Ho and Murakami teach the same as stated in claim 5 argument. Balogh teaches: "embedding a URL with the related image pasted into the document, the URL providing a link to information associated with the related image" at Col. 17 lines 2-12.

**As per claim 40**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: " the network component employs a transmission device to automatically connect to the search engine for the database, the transmission device including cable modem, network interface card, telephony modem, satellite dish and radio transceiver" at Col. 16 lines 20-40.

**As per claim 41**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches the step of "employing the network component to automatically connect to the search engine for the database when the search engine is remotely located from the indicated text" at Col. 16 lines 20-40.

**As per claim 42**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component employs a proxy server to automatically connect to the search engine for the database" at Fig. 11.

**As per claim 43**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component employs a dial up facility to automatically connect to the search engine for the database" at Col. 16 lines 25-40.

**As per claim 44**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component launches a browser to automatically connect to the search engine for the database" at Col. 16 lines 40-50.



**As per claim 45**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component automatically connects to the search engine" at Col. 16 lines 20-40.

**As per claim 46**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component launches a browser to manage a purchase of a higher quality image associated with the related images" at Col. 17 lines 39-65.

**As per claim 47**, Ho and Murakami teach the same as stated in claim 18 argument. Balogh teaches: "the network component manages a purchase of a higher quality image associated with the related image" at Col. 17 lines 39-65.

**As per claim 49**, Ho and Murakami teach the claimed invention as discussed above. Ho also teaches the step of "inserting the higher quality image into the document so that the higher quality images is displayed with the indicated text" at Fig. 12.

Ho and Murakami do not teach the steps of: "indicating a higher quality image of the related image is to be purchased over a network; and providing financial information to an electronic commerce service over the network, the electronic commerce service enabling the purchase of the higher quality image when the financial information is complete".

However, Balogh teaches the cited steps as "if the user selects the pricing button from lightbox commands area or info screen commands area, pricing screen is

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displayed, enabling the user to purchase rights to, and obtain delivery of, selected images ..." at Col. 17 lines 25-65.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine Ho's image database searching method with Balogh's purchasing step so that "the user may order and obtain delivery of selected images directly over a computer connection" (Balogh, Col. 2 lines 5-7).

6. **Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho and in view of Balogh.**

**As per claim 51**, Ho teaches a method for searching an image database comprising:

- "automatically creating a query related to an indicated object, the query having a data structure that is recognizable by a search engine for the database" at Col. 1 lines 50-63;
- "providing the query to the search engine, the search engine searching the database for at least one image that is related to the indicated object" at Col. 1 lines 63-67;
- "returning the result from the query of the database, the result indicating when at least one image is related to the indicated object" at Col. 1 lines 63-67;
- "enabling a display of the related image, so that the related image may be associated with the indicated object" at Col. 1 line 67 to Col. 2 line 3.

Ho does not teach the step of: "indicating a related image is to be purchased over the network, financial information being provided to an electronic

commerce service that enables the purchase of the related image when the financial information is complete”.

However, Balogh teaches the cited steps as “if the user selects the pricing button from lightbox commands area or info screen commands area, pricing screen is displayed, enabling the user to purchase rights to, and obtain delivery of, selected images ...” at Col. 17 lines 25-65.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine Ho and Murakami database searching method with Balogh’s purchasing step so that “the user may order and obtain delivery of selected images directly over a computer connection” (Balogh, Col. 2 lines 5-7).

**As per claim 52**, Ho also teaches: “the indicated object includes data, comprising video, picture, sound, and text” at Col. 9 lines 25-30.

**As per claim 53**, Ho also teaches the following steps:

- “enabling a qualification engine to determine a context of the indicated object” at Col. 1 lines 50-65; and
- “employing the context of the indicated object to automatically create the query for the database” at Col. 1 lines 63-67.

7. **Claim 17 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Ho as applied to claim 5 above, and in view of Baru et al (“XML Based information Mediation for Digital Libraries.”)

**As per claim 17**, Ho teaches the same as stated in claim 5 argument. Ho does not teach "the query's data structure include XML". However, Baru teaches: "the query's data structure include XML" at page 214, Col. 1. Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to implement Ho's invention using XML in order to provide a user-friendly query formulation and optimization.

### ***Response to Arguments***

8. Applicant's arguments filed April 16, 2003 regarding the 102(e) rejection have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments regarding the 103(a) rejection have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments

In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As stated in the previous Office Action dated 9/6/2002, the difference between Ho and the invention of claims 4, 51 is that Ho does not disclose the step of allowing users to purchase images over the network as claimed. However, buying and selling digital objects over the network are well known in the art, as exemplified by Balogh. As noted by Balogh, it is desirable that

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"the user may order and obtain delivery of selected images directly over a computer connection" (Col. 2 lines 5-7). Consequently, it would have been obvious to those of ordinary skill in the art at the time of the invention to modify Ho's reference to add the purchasing step as claimed, financial gain is of course an obvious reasonable expectation of success.

The proposed combination of the references does not change the principle of operation of the references because both Ho and Balogh deal with searching and retrieving digital image from an image database using keyword and displaying the search result to user. Balogh also allows user to purchase the image in the search results before it can be used. Adding the step of purchasing the image to Ho's invention is obvious because buying and selling digital objects over the network are well known in the art, as exemplified by Balogh.

In light of the foregoing arguments, the 35 U.S.C 103 rejections are hereby sustained.

### ***Conclusion***

10. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(703) 305-9601** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (703) 308-

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7299. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)746-7240.

Khanh B. Pham  
Examiner  
Art Unit 2177

KBP  
May 28, 2003

  
JEAN R. HOMERE  
PRIMARY EXAMINER